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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
DORNBUSCH, DIANNE	
ART UNIT	PAPER NUMBER
3773	

MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/549,375	WILD, ANDREW MICHAEL	
	Examiner	Art Unit	
	DIANNE DORNBUSCH	3773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 April 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *3-9 and 11-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *3-9 and 11-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 3, 2009 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 7-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 states “a first plane and a second plane,” it is unclear to the examiner if the first plane in the claim is the same as the first plane in claim 23.

Claims 8 and 9 state that the base portion is generally planar and defines a first plane. This limitation is the same as the limitation in claim 23 where the base and the first plane are introduced. It is also unclear to the examiner if another plane is being introduced as the first plane or it is the same as the one in claim 23.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

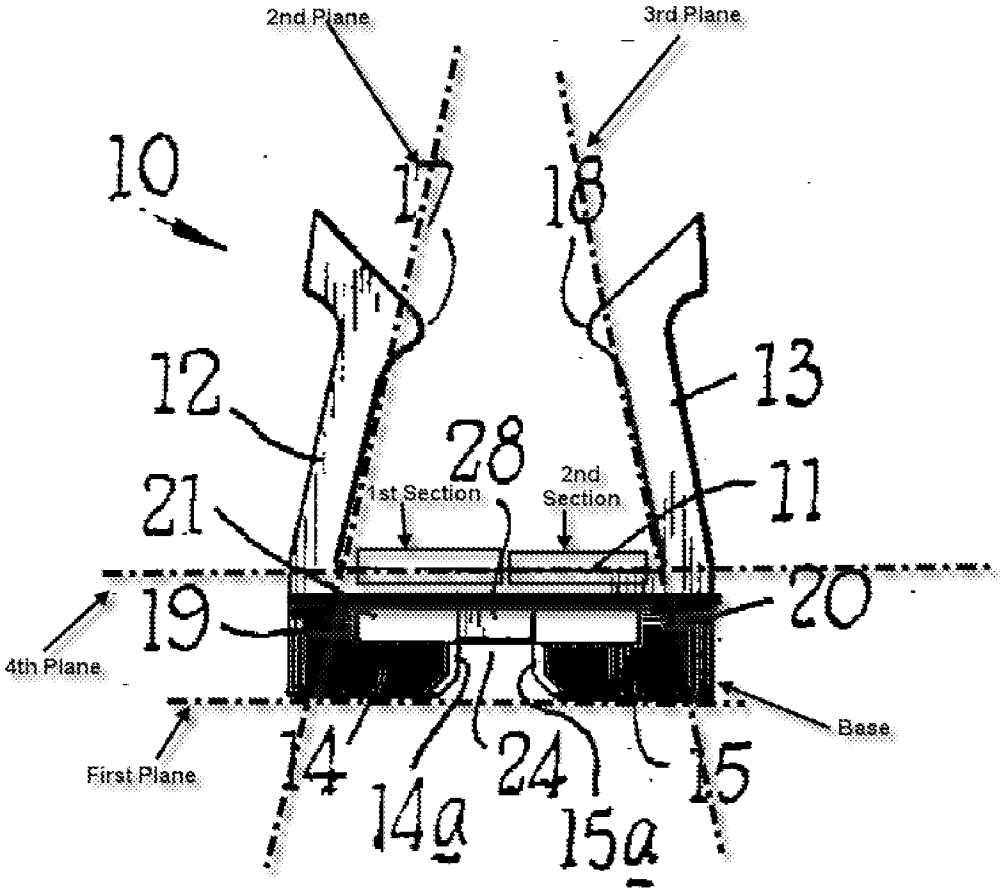
5. Claims 3-9, 11, 14-16, and 22-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Seckerson et al. (3,807,675).

Seckerson discloses the following claimed limitations:

Claims 23 and 24: A generally planar base portion (see figure below where the area filled is the base) defining a first plane (see figure below); a first resilient arm (12) extending from the base portion (figure below) and having a curved distal end portion (17) defining a first contact surface (inner surface of the arm and curved portion) and disposed in a second plane (see figure below) offset to a first side of the first plane (figure below and Fig. 6-7 where the contact surface is contacting part 16); a second resilient arm (13) extending from the base portion and having a curved distal end portion (18) defining a second contact surface (inner surface of the arm and curved portion) and disposed in a third plane (see figure below) offset to a second side of the first plane (figure below and Fig. 6-7 where the contact surface is contacting part 16), whereby the first and second contact surfaces curve generally toward each other (Fig. 6-7); and a third contact surface (11) comprising a first section (see figure below) and a second section (see figure below) extending from the base portion (see figure below), each section having a generally horizontal reaction surface (the reaction surface is the

surface of 11 that contacts the part 16 which reacts by exerting a normal force on the part 16) and disposed on a fourth plane (see figure below) offset from the first plane and distinct from the second and third planes; whereby the third contact surface is disposed generally between the first and second arms when the clip is viewed parallel to the first plane (see figure below); whereby the first and second arms can pivot independently of the third contact surface (Fig. 1, 5-7), whereby the first resilient arm and the second resilient arm are offset from the third contact surface (Fig. 1 and 5) such that, when contacting a body passageway comprising an elongated tube-like structure (16) having a longitudinal axis, the first contact surface contacts the body passageway at a first longitudinal position on the body passageway, the second contact surface contacts the body passageway at a second longitudinal position and the third contact surface contacts the body passageway at a third longitudinal position (Fig. 6-7), such that the body passageway is contacted at three longitudinally distinct locations by the first, second and third contact surfaces (Fig. 6-7), and whereby the co-operation of the first, second and third contact surfaces can compress the body passageway and substantially reduce the diameter of the body passageway, so as to substantially prevent the flow of fluid through the passageway.

With respect to the last statement, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).



Claim 3: The base portion and reaction portions are disposed generally centrally between the pair of limbs (Fig. 1 and figure above).

Claim 4: The reaction surface is substantially fixed in relation to the movement of the limbs (Fig. 5-7).

Claim 5: The reaction surface is elongate (Fig. 1 where the reaction surface is the part 11 as explained in the rejection of claim 23 and 24 above).

Claim 6: The reaction surface and the limbs are suitably dimensioned and arranged so that in the closed condition of the clip substantially the entire transverse width of the occluded body passageway (16) is in contact with the reaction surface (Fig. 6-7).

Claims 7 and 8: At least two parts of the clip (10) are generally planar (the base (see figure above which includes parts 14, 15, 19, and 20) and the reaction surface (11)) (Fig. 1 and above), defining at least a first plane (see figure above) and a second plane (see figure above where the plane of the reaction surface is labeled as the 4th plane), the first and second planes being offset from one another (Fig. 1 and above). The planes indicated above for both the reaction and base portion are at the same location therefore the angle is approximately 0 degrees which is a small angle.

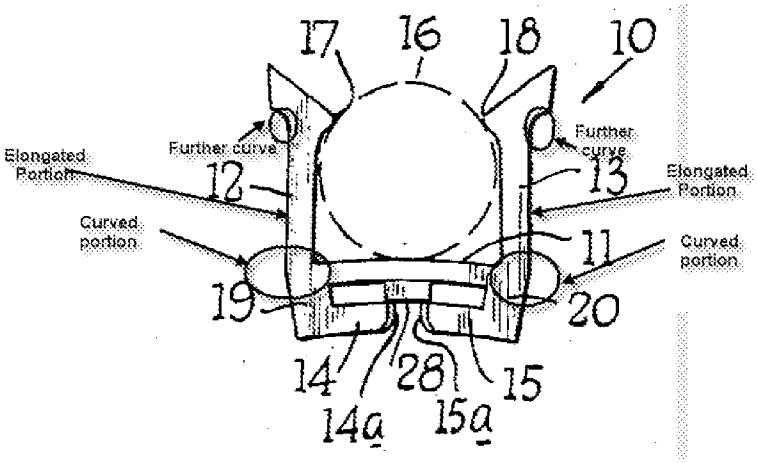
Claim 9: The base portion is generally planar and defines a first plane (see figure above), the reaction portion is generally planar and defines a second plane (see figure above where the plane of the reaction surface is labeled as the 4^{th} plane) and each limb are generally planar and define a third and fourth plane (the limb planes are labeled as the 2^{nd} and 3^{rd} plane in the figure above) and the plane of each limb is at a small angle to the first plane of the base portion and the second plane of the reaction portion (the angle between the limb planes and the base and reaction planes is less than 90 degrees which is a small angle. In addition, the limbs can have another plane which is parallel to the limb and reaction surface planes which would have an angle of 0 degrees which is a small angle).

Claim 11: The reaction surface is shaped in a manner generally complementary to the shape of those parts of each limb which cooperate with the reaction surface in the closed condition of the clip (Fig. 1).

Claim 14: Each limb is connected to the base portion of the clip via a curved portion of the limb (see figure below) defining a connection point to the base portion behind the reaction portion of the clip (see figure below).

Claim 15: A further curve (see figure below) is provided in the limb in the opposite direction to the said curved portion, whereby the free end of the limb is disposed forward of the base portion of the clip (see figure below).

Claims 16 and 22: An elongate portion (see figure below) is provided in each limb between the curves (see figure below), whereby during closure a leverage effect is produced on the part of the limb which is in contact with the body passageway (Fig. 5-7).



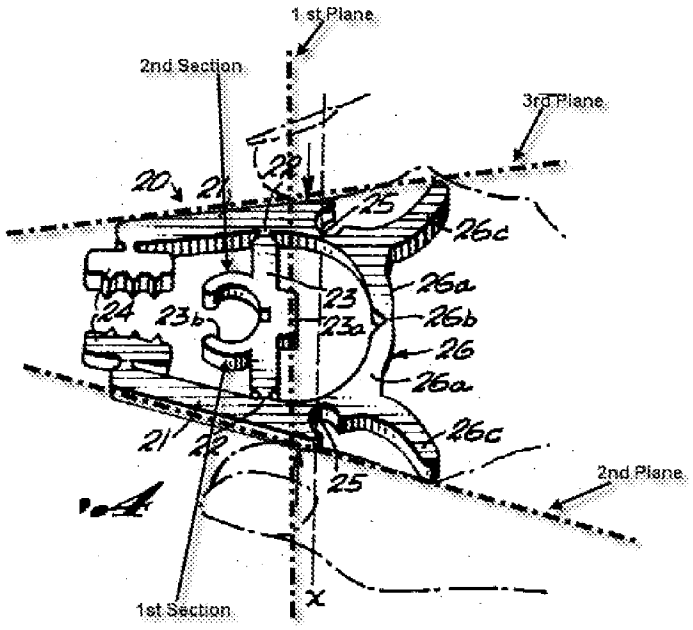
6. Claims 17-20 and 23-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Esposito (3,616,497).

Esposito discloses the following claimed limitations:

Claims 23 and 24: A generally planar base portion (23 and 23a) defining a first plane (see figure below); a first resilient arm (21) extending from the base portion (Fig. 3) and having a curved distal end portion (Fig. 3-4) defining a first contact surface (24) and disposed on a second plane (see figure below) offset to a first side of the first plane (figure below); a second resilient arm (21) extending from the base portion and having a curved distal end portion (18) defining a second contact surface (24) and disposed in a third plane (see figure below) offset to a second side of the first plane (figure below), whereby the first and second contact surfaces curve generally toward each other (Fig. 3-4); and a third contact surface (23b) comprising a first section (see figure below) and a second section (see figure below) extending from the base portion (see figure below), each section having a reaction surface (23b) (Fig. 5) and disposed on a fourth plane (the plane perpendicular to the 1st plane) offset from the first plane and distinct from the second and third planes; whereby the third contact surface is disposed generally between the first and second arms when the clip is viewed parallel to the first plane (see figure below); whereby the first and second arms can pivot independently of the third contact surface (Fig. 3-5), whereby the first resilient arm and the second resilient arm are offset from the third contact surface (Fig. 3-5) such that, when contacting a body passageway comprising an elongated tube-like structure having a longitudinal axis, the first contact surface contacts the body passageway at a first longitudinal position on the

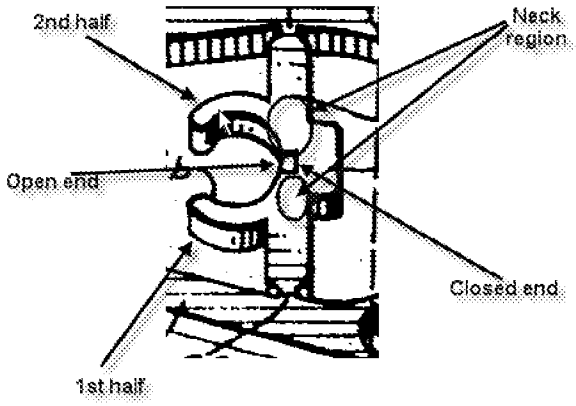
body passageway, the second contact surface contacts the body passageway at a second longitudinal position and the third contact surface contacts the body passageway at a third longitudinal position (Fig. 5), such that the body passageway is contacted at three longitudinally distinct locations by the first, second and third contact surfaces (Fig. 5), and whereby the co-operation of the first, second and third contact surfaces can compress the body passageway and substantially reduce the diameter of the body passageway, so as to substantially prevent the flow of fluid through the passageway.

With respect to the last statement, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).



Claim 17: The base portion of the clip is in the form of an open loop or generally U_ shaped member (23a is in u-shape) having a closed end directed away from the limbs (see figure below) and an open end (see figure below) at which the limbs and the reaction portion are connected to the base portion (Fig. 3).

Claim 18: The reaction portion of the clip is provided in two halves (see figure below), each half is connected to one side of the open end of the base portion via a neck region (see figure below) and which are complementarily juxtaposed to define the reaction surface of the clip (see figure below).



Claim 19: The base portion of the clip is provided with a weak region or point (22) at which the base portion may be cut to remove the clip from the body passageway. Regarding the last statement, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

Claim 20: The clip is integrally formed of a superelastic or pseudoelastic shape memory material (Col. 3 Lines 5-10).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

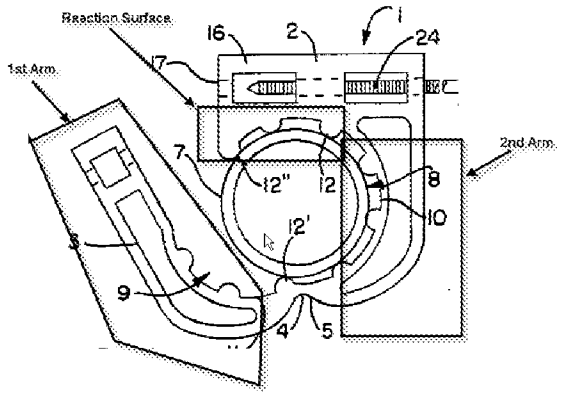
> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seckerson et al. (3,807,675) in view of Cirino et al. (6,164,604).

Claims 12 and 13:

Seckerson teaches all the claimed limitations discussed above however, Seckerson does not disclose surface projections on the resilient arms and reaction surface.

Cirino discloses a clip (1) with a base (2), first and second arms (see figure below), a reaction surface (see figure below); where the reaction surface and arms have surface projections (12) in the shape of rounded teeth (Fig. 1).



It would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide Seckerson with surface projections in view of the teachings of Cirino, in order to compressibly grip the exterior surface of the tubular member.

9. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Esposito (3,616,497).

Esposito discloses the claimed invention including that the device can be integrally formed of a plastic (Col. 3 Lines 5-10), however Esposito does not disclose that the clip can be integrally formed of nitinol metal. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the clip out of nitinol metal, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Response to Arguments

10. Applicant's arguments filed on April 3, 2009 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DIANNE DORNBUSCH whose telephone number is (571)270-3515. The examiner can normally be reached on Monday through Thursday 7:30 am to 5:00 pm Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. D./
Examiner, Art Unit 3773
/(Jackie) Tan-Uyen T. Ho/
Supervisory Patent Examiner, Art Unit 3773